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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,947	06/27/2003	Wilfred E. Pearce	BOEI-1-1148	3077

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EXAMINER

PECHHOLD, ALEXANDRA K

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,947

Applicant(s)

PEARCE ET AL.

Examiner

Alexandra K Pechhold

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Baerveldt (US 5,338,130).**

Regarding claim 1, Baerveldt discloses an expansion joint comprising:

- a first generally planar member seen as the bottom planar surface of sealing strip (S) in Fig. 1, which is certainly capable of slidably supporting a first portion of at least one section of a structure thereon,
- second and third generally planar members seen as retaining elements (2) in Fig. 1, which are also certainly capable of being attachable to a second portion of at least one section of the structure thereon, these members being substantially co-planar with each other (as Fig. 1 shows) and substantially parallel to the first member (again see Fig. 1), the second and third members being vertically spaced-apart from the first member (see Fig. 1), and
- an expansion device between the second and third members seen as the rest of the sealing strip (S), which is capable of being attached to a

support member that supports the at least one section of the structure thereon.

Regarding claim 2, the center of the strip (S) has a slit extending downward along its length, which can be viewed as a hole, and it is certainly capable of receiving a fastener therein.

Regarding claim 3, Fig. 1 illustrates adjacent sections of the structure, seen as (1) and (2).

Regarding claim 4, the retaining elements (2) shown in Fig. 1 each define a hole for receiving a fastener therein.

Regarding claim 5, the at least one section, seen as (1) in Fig. 1, is capable of allowing sliding of an overlapping portion of a second section thereon.

Regarding claims 6 and 7, composite materials are disclosed in column 2, lines 44-48, with some materials (such as thermoplastic elastomer) having equivalent expansion characteristics.

Regarding claim 8, bridge and bridge decks are disclosed in column 1, lines 7-11.

Regarding claim 9, the flexible seal strip (S) can be viewed as an expansion spring, which has a hole, seen in Fig. 1 as the longitudinal valley in the center extending downwards from the top, or the two channel-like holes extending through the interior.

Regarding claim 10, a stiffening member can be viewed as deflector elements (3) in Fig. 1.

Regarding claim 11, Baerveldt discloses the limitations of the claimed invention as discussed in regards to claim 1 and 9 above. The sealing strip (S) defines a hole that is capable of receiving a fastener therein that is capable of attaching the expansion spring to a support member that supports the adjacent sections of the structure thereon. With respect to the recitation "for attaching the expansion spring to a support member that supports the adjacent sections of the structure thereon", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 12 and 13, composite materials are disclosed in column 2, lines 44-48, with some materials (such as thermoplastic elastomer) having equivalent expansion characteristics.

Regarding claim 14, bridge and bridge decks are disclosed in column 1, lines 7-11.

Response to Arguments

3. Applicant's arguments filed 2/25/05 have been fully considered but they are not persuasive.

Applicant has amended independent claims 1 and 11, but the amendments do not overcome the rejections using Baerveldt (US 5,338,130). Claim 1 recites that the first generally planar member is "configured to slidable support a first portion of at least

one section of a structure thereon", a slight variation of the recitation in claim 11 of "configured to slidably receive first portions of adjacent composite sections of a structure thereon". The Examiner is viewing this first planar member as the planar bottom surface of (S) in Fig. 1. The language "configured to" does not recite the combination of elements, but instead merely requires the planar bottom surface of (S) to be capable of performing the function. The applicant is not claiming a positive limitation but only requires the ability to so perform the desired supporting, and the bottom surface of sealing strip (S) is capable of slidably support a first portion of a structure thereon.

Similarly, the recitation in claim 1 of "the expansion device being attachable to a support member that supports the at least one section of the structure thereon" merely requires that the expansion part of the sealing strip (S) be capable of being attached to a support member that supports the at least one section of the structure thereon, which it is certainly capable of doing. Amended claim 11 recites "for attaching the expansion spring to a support member that supports the adjacent sections of the structure thereon", which is an intended use recitation. The sealing strip (S) defines a hole that is capable of receiving a fastener therein that is capable of attaching the expansion spring to a support member that supports the adjacent sections of the structure thereon. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandra Pechhold whose telephone number is (571) 272-6994. The examiner can normally be reached on Mon-Thurs. from 8:00am to 5:30pm and alternating Fridays from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (571) 272-6998. The fax phone number for this Group is (703) 872-9306.


Thomas B. Will
Supervisory Patent Examiner
Group 3600

AKP
5/9/05